

**REMARKS**

Reconsideration and allowance of the above identified application are requested.

*Information Disclosure Statement*

The attached IDS includes documents cited in this response to the Office action dated October 20, 2004. A check that includes the fee for submitting the IDS after the first Office action is enclosed.

*Specification.*

The paragraph that starts on page 2, line 27 is amended to clarify the claimed invention within the scope of the original application. The Applicant's invention claims soups made with an emulsified liquid shortening composition comprising dietary fiber gel. The dietary fiber gel of the invention is disclosed by Inglett (U.S. Patent, Number 5,766,622, dated June 16, 1998), which was incorporated by reference into the original as-filed application at page 2, line 32. Information included by reference is "as much a part of the application as filed . . . , and should be treated as part of the text of the application as filed." MPEP § 2163.07(h). Clearly, dietary fiber gel as disclosed by Inglett is part of the as-filed application.

Inglett teaches at Col. 1, lines 9-12, that it is well known that "[d]ietary fibers are generally considered to be the soluble and insoluble components of cell walls . . . [and] consist primarily of cellulose, hemicellulose," and so forth. In the process of the invention, Inglett at Col. 3, lines 24-32, explicitly teaches that "[f]ollowing at least the second stage of treatment . . . the solids are separated for the liquids and the recovered insolubles are carried forward to the next processing step, [wherein] the second stage separation is intended to isolate and recover the gel product of this invention," i.e., dietary fiber gel. The source of the dietary fiber is agricultural by-products such as grain seed brans, hulls, and so forth is noted by Inglett at Col. 3, lines 3-8.

Inglett implicitly teaches that dietary fiber gel is insoluble dietary fiber derived from the alkaline treatment of agricultural by-products. Inglett at Col. 3, line 33 to Col. 4, line 36 teaches the first stage of treatment is "preferably in the range of about . . . pH 9-13. The gel products . . . contained in the insoluble fraction . . . from the first stage . . . are subjected to [a] second stage . . . [of] treatment . . . at alkali pHs, preferably in the range of 7-12. Following the second stage . . .

solids are again separated from the liquids . . . [and] the recovered solids consist of cellular debris in the form of a hydrated gel. The gel may be dried.” One skilled in the art would know that solids separated from liquid after the second stage are implicitly insoluble dietary fiber. Clearly, because Inglett explicitly and implicitly teaches dietary fiber gel as the insoluble component of dietary fiber that can be recovered and formed into a gel, so does the as-filed application.

As to the physical form of the dietary fiber gel, Inglett at Col. 5, lines 43-45, explicitly teaches that dietary fiber gel “may exist in either the hydrated form as gels or in the dehydrated form as flakes or powder.”

Inglett inherently teaches an amorphous dietary fiber gel because the gel exhibits a smooth morphology. For example, at Col. 4, line 63 to Col. 5, line 3, Inglett teaches that dietary fiber gel has “a smooth sheet- or film-like morphology” based on scanning electron photographs at magnifications of 500-1000X, and “[t]he smoothness of the original gels are restored after reconstitution of the dried products.” Typically, crystal structures are characterized by sharp edges that result in rough, jagged, and under scanning electron microscopic magnification a generally non-smooth morphology such that one skilled in the art would know that dietary fiber gel that has a smooth morphology would be inherently amorphous.

Thus, dietary fiber gel in the Applicant’s invention comprises non-particulate amorphous insoluble dietary fiber derived from the alkaline treatment of agricultural by-products. Although the specification has been amended so as to more reasonably convey the invention, and more specifically what dietary fiber gel is to one skilled in the art, the amendments to the specification are expressly, implicitly, or inherently supported by the Inglett patent, a part of the original as-filed application.

### *35 U.S.C. § 102 Claim Rejection.*

The Applicants traverse the rejection of Claims 1-3 as anticipated under 35 U.S.C. § 102 (b) because the McGinley reference cited in the Examiner’s Office Action teaches fat substitutes comprising coated microcrystalline cellulose and water. The coated microcrystalline cellulose includes at least two components, an inner core of microcrystalline cellulose and a coating of galactomannan gum. Optionally, addition components such as flavor enhancing lipids can coat the microcrystalline cellulose core. The Applicant’s invention on the other hand discloses a fat

substitute for use in making soups that comprises non-coated, amorphous dietary fiber gel, water and a lipid, wherein the lipid is the fat and oil component of the shortening.

There is nothing disclosed in McGinley that anticipates the Applicants' invention as suggested by the Examiner. Anticipation depends upon prior publication of the invention. 35 U.S.C. § 102(b). The establishment of anticipation requires that every element and limitation of the claimed invention can be found in a single prior publication. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The Applicants traverse the rejection because nothing in McGinley teaches all the elements and limitations of the Applicants' claimed invention.

McGinley teaches a fat substitute comprising an aggregate and water. The aggregate is a coated microcrystalline cellulose spheroid particle wherein an outer surface of the particle is coated with a gum. Optionally, the aggregate can be further covered with a flavor enhancing lipid. Although the Examiner implied that aggregate in McGinley is the same material as dietary fiber gel, the aggregate in McGinley is in fact a different compound than dietary fiber gel.

McGinley does teach certain foods that comprise a fat substitute comprising coated microcrystalline cellulose and water, but McGinley does not specifically teach soups. The applicant's invention on the other hand teaches soups comprising emulsified liquid shortening. The emulsified liquid shortening, a fat substitute, comprises non-coated amorphous dietary fiber, water, and lipid, wherein the lipid is the fat and oil component of the shortening. Nothing in the cited prior art reference teaches the claimed invention, soups comprising emulsified liquid shortening comprising non-coated amorphous dietary fiber gel, water, and lipid, wherein the lipid is the fat and oil component of the shortening.

For example, at Col. 1, lines 19-22, McGinley teaches a fat substitute which "relates to a substantially spheroidal shaped particulate aggregate of microcrystalline cellulose (MCC) and a galactomnannan gum (GG) . . . which has a fat-like consistency, appearance and mouth feel when reconstituted in food." McGinley specifically defines aggregate at Col. 1, lines 31-35, as "a stable, substantially physical mixture of two or more components in its wet or dry state but which is more firmly bound when dried, yet remains intact if reconstituted in water under typical food processing conditions." McGinley further teaches at Col. 5, lines 20-26, that aggregate stability is achieved when the gum in the aggregate composition is present "in an amount sufficient to cover and form a stable aggregate with the MCC and thus provide sufficient cover

of the MCC particles to mask the characteristic taste of the cellulose.” At Col. 5, lines 32-33, McGinley further notes that particulate aggregates are produced such that “the gum covers, i.e., is absorbed on, the cellulose.” Optionally as taught by McGinley at Col. 6, lines 45-61, a third component can be added to the aggregate “to impart additional properties” to the aggregate, such as “for the purpose of modifying the surface characteristics of the MCC-GG aggregate by creating the flavor and taste sensation of fat.” The coated microcrystalline cellulose is dispersed in water to form a fat substitute as disclosed by McGinley at Col. 7 line 57 to Col. 8 line 20. At Col. 8, lines 21-25, McGinley teaches the fat substitute can be used in “other foodstuffs” without specifically naming soups. Thus, McGinley teaches other foodstuffs comprising a fat substitute comprising coated microcrystalline cellulose, and water, wherein the coated microcrystalline cellulose can optionally further comprise a flavor enhancing lipid, but does not teach soups comprising emulsified liquid shortening comprising non-coated dietary fiber gel, water and lipid, wherein the lipid is the fat and oil component of the liquid shortening.

Finally, McGinley teaches generally “other foodstuffs” comprising emulsified liquid shortening, while this application, Application No. 10/689,193, is directed towards the specific use of emulsified liquid shortenings in soups. Although McGinley’s invention for “other foodstuffs” may anticipate a genus of food products that comprise a fat substitute comprising coated microcrystalline cellulose, nothing in McGinley specifically teaches a separate and distinct food specie of soups that are formulated with an emulsified liquid shortening comprising dietary fiber gel, water, and lipid.

#### *Nonstatutory Double Patenting Rejection.*

The Applicant traverses the provisional rejection of Claims 1-3 as obviousness-type double patenting based on a judicially created doctrine because the references, Application No. 10/689,193 teaches dips comprising emulsified liquid shortening. The Applicant’s invention on the other hand teaches the patentably distinct species of soups comprising emulsified liquid shortening.

#### The References Do Not Teach the Claimed Invention

There is nothing disclosed in the copending Application No. 10/689,193 for dips that teaches the modification of the references suggested by the Examiner. Obviousness, including

obviousness-type double patenting, depends on the differences between a claimed invention and the prior art. *See generally*, 35 U.S.C. § 103(a). The establishment of obviousness requires that the prior art must teach or suggest all the limitations of the claimed invention. *See also, In re Royka*, 490 F.2d 981, 984-85 (CCPA 1974). The Applicant traverses the rejection because nothing in Application No. 10/689,193 teaches all the elements and limitations of the Applicant's claimed invention.

The current application, Application No. 10/689,274, teaches soups, including soup mixes and concentrates, comprising emulsified liquid shortening that contains dietary fiber gel such that the solids within the dietary fiber gel represent 0.25 percent to 5.0 percent of the overall soup formulation. The cited copending application, Application No. 10/689,193, teaches dips, including dip mixes, comprising emulsified liquid shortening that contains dietary fiber gel such that the solids within the dietary fiber gel represent 0.5 percent to 7.0 percent of the overall dips formulation. The inventions are patentably distinct because dips are creamy mixtures while soups are water based foods.

For example, a dictionary definition of soup is "a liquid food made by cooking meat, fish, vegetables, and other ingredients in water, milk, or stock," while a dictionary definition of dip is "a creamy mixture into which pieces of food can be dipped, often served with crackers or chips," such as "sour cream and onion dip." One skilled in the art would know that dipping crackers or chips into a water based food as opposed to a sour cream based food would yield crackers or chips with undesirable characteristic such as a soggy texture, a loss of physical integrity and strength, and so forth. Clearly, one skilled in the art would know the soups and dips are patentably distinct because dips are not water based foods.

McGinley, the prior art reference cited by the Examiner, provides further evidence that the inventions are patentably distinct. For example, McGinly, at Col. 8, lines 21-25, includes soups in a list of "like water-based foods" that can accept a coated microcrystalline cellulose fat substitute. The list does not explicitly include dips, such that McGinley implicitly teaches that dips are inherently a different and patentably distinct species of food from "water-based foods" such as soups. In addition, neither copending application disclose, describe, or claim dips and soups together as related food groups so as to be patentably indistinct. Finally, the Examiner alleged that the inventions are not patentably distinct; however, the Examiner offered no specific evidence of this alleged fact.

Although the claimed invention in co-pending application, Application No. 10/689,193, for dips has elements that are similar to the elements in the current application, Application No. 10/689,274 for soups, all the limitations or elements of the current inventions are not taught because the ranges of the similar elements are not identical, and because the subject matter as giving in the preamble of the claims are directed to patentably distinct inventions. Clearly, Application No. 10/689,193 teaches dips having a certain range of dietary fiber gel, and does not teach soups as in Application No. 10/689,274 having a substantially different range of dietary fiber gel.

#### The References Lack Any Suggestion to Combine

There is nothing disclosed in copending Application No. 10/689,193 for dips that teaches the modification of the references suggested by the Examiner. Obviousness requires that the suggestion to make the claimed invention must found in the prior art. *See generally, In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Such a suggestion is lacking in the cited references. Even if the references fully taught the Applicant's invention, the Applicant traverses the rejection because nothing in copending Application No. 10/689,193 affirmatively suggests making the cited combination.

Copending Application No. 10/689,193 teaches dips, including dip mixes, comprising emulsified liquid shortening that contains dietary fiber gel. The Applicant's current invention, Application No. 10/689,274, on the other hand teaches soups comprising an emulsified liquid shortening comprising dietary fiber gel. Nothing in Application No. 10/689,193 teaches or suggests soups comprising emulsified liquid shortening that contains dietary fiber gel.

More specifically, copending Application No. 10/689,193 teaches the food product specie of dips that comprise emulsified liquid shortening, a fat substitute that comprises dietary fiber gel, water, and lipid. Application No. 10/689,193 does not teach or suggest any other food product species formulations that use an emulsified liquid shortening comprising dietary fiber gel, water, and lipid.

#### Combining the References Lacks a Reasonable Expectation of Success

There is nothing disclosed in copending Application No. 10/689,193 that teaches a reasonable expectation of success in combining the references as suggested by the Examiner.

Obviousness exists when the references provide a reasonable expectation of success for the proposed combination. *See generally, In re Merck & Co., Inc.*, 800 F.2d 1091, 1097-98 (Fed. Cir. 1986). Whether the combination is obvious or unobvious requires consideration of all the evidence and resultant findings. *See also, In re Rinehart.*, 531 F.2d 1048, 1052 (CCPA 1976). Such an expectation of success is lacking in the cited reference. Even if the references fully taught the Applicants invention, the Applicant traverses the rejection because nothing in copending Application No. 10/689,193 for dips leads to an expectation of success for the identified combination.

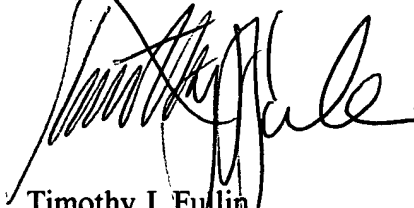
For example, based on common dictionary definitions of dip and soup, copending application, Application No. 10/689,193, teaches dips that are creamy mixtures, such as sour cream, onion dip, and so forth, while the Applicant's current application 10/689,274, teaches soups that are generally water based foods. One skilled in the art would know that a creamy food product such as dips is not a watery food product such as soups. Nothing in the cited reference teaches any expectation that a component such as emulsified liquid shortening that is used to make a creamy food product, such as dips, can also be use to make a watery food product, such as soups. For example, there is no explicit mention of soups in Application No. 10/689,193. Clearly, Application No. 10/689,193 does not teach any expectation that emulsified liquid shortening used for dips can be used for soups. Nothing in Application No. 10/689,193 for dips provides any expectation that a separate and distinct food product species, such as soups, can be successfully formulated with an emulsified liquid shortening comprising dietary fiber gel, water, and lipid.

Applicant has amended the specification to clarify the foregoing distinctions. In view of the amendment, and above arguments, Applicant requests that the rejections of Claims 1-3 as being obvious under 35 U.S.C. § 103 (a) be withdrawn. Further, in view of the amendment, and above arguments, Applicant requests that the provisional rejections of Claims 1-3 under nonstatutory obviousness-type double patenting based on a judicially created doctrine be withdrawn.

Applicant believes that the amended patent application is now in condition for allowance. Accordingly, the Applicant respectfully requests that a Notice of Allowance be issued in this

case. The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes this would advance the prosecution of the matter.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Timothy J. Fullin', written over a horizontal line.

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